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LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112			SERGENT, RABON A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WERNER OBRECHT and MARTIN MEZGER

Appeal 2009-005117
Application 09/739,034
Technology Center 1700

Decided: March 30, 2010

Before MICHAEL P. COLAIANNI, BEVERLY A. FRANKLIN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 8-10 and 23-32 (Final Office Action ("Final"), mailed Dec. 21, 2007, 1), the only claims pending in the Application. (Appeal Brief ("App. Br."), filed Jul. 21, 2008, 1.) We have jurisdiction under 35 U.S.C. § 6(b).

Representative independent claim 8 is reproduced below:

8. A non-adhesive rubber vulcanate comprising rubber mixtures, which comprise uncrosslinked, double-bond containing rubbers (A), crosslinked rubber particles (B), multifunctional isocyanates (C), wherein the amount of component (B) in the mixture is from 1 to 150 parts by weight and the amount of multifunctional isocyanates (C) is from 1 to 100 parts by weight, in each case based on 100 parts by weight (phr) of the rubber component (A) and wherein said crosslinked rubber particles (B) have particle diameters of from 5 to 1000 nm and swelling indices in toluene of from 1 to 15 and wherein the gel content of the rubber particles (B) is from 80 to 100 wt.%.

The Examiner relies on the following evidence in support of unpatentability (Examiner's Answer ("Ans."), mailed Sep. 23, 2008, 2-3):

Dammann	5,232,531	Aug. 03, 1993
Obrecht	6,127,488	Oct. 03, 2000
Mizumoto (JP '239)	JP 57-212239	Dec. 27, 1982
Kamakura (JP '630)	JP 5-17630	Jan. 26, 1993
Eisele (DE '487)	DE 19701487	Jul. 23, 1998

The Examiner maintains (Ans. 3-5), and Appellants request review of (App. Br. 8), the following grounds of rejection:

1. claims 8-10 and 23-32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and

2. claims 8-10 and 23-32 under 35 U.S.C. § 103 as unpatentable over Obrecht or DE '487, in view of Dammann or JP '239 or JP '630.

All of the appealed claims are limited to "A non-adhesive rubber vulcanate" (independent claim 8) or "A molded non-adhesive rubber body" (independent claim 9).

In the body of the rejection under 35 U.S.C. § 112, first paragraph, the Examiner states: "[A]ppellants have in no way defined exactly what is meant by non-adhesive," and "it cannot be determined exactly what degree of non-

adhesiveness is encompassed by the language [of the claims].” (Ans. 3.) In responding to Appellants’ arguments, the Examiner further asserts that:

it cannot be determined if the “non-adhesive” property is an absolute property in that the composition is totally devoid of adhesive properties or if the property is a relative property in that the term is satisfied if the adhesive property is less than what is observed for the disclosed prior art compositions. On the face of it, the term, “non-adhesive” appears to require a total lack of adhesive properties; however, this is by no means clear in view of the argued disclosures within the specification.

(Ans. 6.)

The test for determining compliance with the written description requirement [of 35 U.S.C. § 112, first paragraph,] is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

In re Kaslow, 707 F.2d 1366, 1375 (Fed. Cir. 1983) (citations omitted). Thus, in considering whether the claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph, the Examiner must first determine the scope of the claims. *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 2010 WL 1007369, at * 8 (Fed. Cir. 2010) (“Claims define and circumscribe, the written description discloses and teaches.”). Similarly, in order to make a proper comparison between the claimed invention and the prior art, the Examiner must first construe the language of the claims. *See In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994).

Based on the above-noted statements by the Examiner, and as further explained below, we determine that no reasonably definite meaning can be

ascribed to the claim term “non-adhesive.” Therefore, any consideration of the merits of the outstanding rejections would be improperly based on speculative assumptions as to the scope of the claims. *See In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). For this reason, we do not reach the merits, but REVERSE pro forma both grounds of rejection and enter the following NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b):

Claims 8-10 and 23-32 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite due to the claim term “non-adhesive.” The Specification and claims fail to provide a standard by which to measure the amount of adherence a material may exhibit while still falling within the scope of the claim term “non-adhesive. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1351 (Fed. Cir. 2005) (quoting *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984) (“When a word of degree is used . . . the patent’s specification [must] provide[] some standard for measuring that degree” to be definite.)).

The term “non-adhesive” does not appear in the originally filed claims, nor does it appear in the Specification. (See generally, Application as filed on Dec. 14, 2000.) The Specification states that at the time of Appellants’ invention, it was known in the art “to vulcanize natural rubber containing carbon black as the filler with diisocyanates.” (Spec. 2:9-10.) The Specification indicates that vulcanates obtained in this manner are undesirable because they “do not have satisfactory mechanical properties” and “adhere very greatly to the metal parts of the vulcanizing molds that are used.” (Spec. 2:10-12.) The Specification states that an object of the invention is “to provide rubber mixtures that allow the production of

vulcanates having improved mechanical properties.” (Spec. 2:15-16.) However, the Specification does not indicate how much, if any, reduction in adherence of the mixture to the vulcanizing molds is considered necessary to achieve this goal. (*See generally*, Spec.)

Appellants indicate that a vulcanate which “adhere[s] very greatly” is “adhesive” (*see* Reply Brief (“Rep. Br.”), filed Nov. 21, 2008, 5; App. Br. 11-12), while “the skilled artisan could certainly ascertain what is meant by ‘non-adhesive’ based on the[] exemplary embodiments” of molded bodies recited in claim 10, e.g., cable sheaths, hoses, drive belts, etc. (Rep. Br. 4). Appellants indicate that the degree of adhesiveness of these exemplary embodiments “is respectfully very little.” (Rep. Br. 4.)

Absent further evidence, we cannot agree with Appellants’ contention that the ordinary artisan would be reasonably apprised of the scope of the claims. Independent claims 8 and 9 are not limited to molded bodies (or vulcanate rubber used in the production thereof) of the type specifically identified by Appellants as exhibiting “very little” adhesiveness. Rather, claims 8 and 9 appear to encompass rubber vulcanates and molded rubber bodies having a degree of adhesiveness somewhere between “very great” and “very little.” (*See* Spec. 11:8-10 (“[R]ubber mixtures according to the invention . . . are used in the production of molded bodies of any kind.”).) Based on the Specification, one of ordinary skill in the art would not recognize the point at which the degree of adhesiveness of a rubber vulcanate or molded rubber body was such that it ceased to fall within the meaning of the claim term “non-adhesive.” *See Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 705 (Fed. Cir. 1998)

(explaining that a claim is definite if “one skilled in the art would understand the bounds of the claim when read in light of the specification”).

CONCLUSION

We reverse the rejections of claims 8-10 and 23-32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 103 as unpatentable over Obrecht or DE ‘487, in view of Dammann or JP ‘239 or JP ‘630. We enter a new ground of rejection of claims 8-10 and 23-32 under 35 U.S.C. § 112, second paragraph, pursuant to 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED;
37 C.F.R. § 41.50(b)

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